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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,071	01/08/2002	Marc Michael Groz	MMG-002U	4941
7590	01/05/2004		EXAMINER	
MARC M. GROZ 244 Madison Avenue # 377 New York, NY 10016			ONEILL, MICHAEL W	
			ART UNIT	PAPER NUMBER
			3713	
DATE MAILED: 01/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/043,071	GROZ, MARC MICHAEL
	<b>Examiner</b>	<b>Art Unit</b>
	Michael O'Neill	3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 08 January 2002.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-32 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5 and 20-32 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) 1-32 are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 10 April 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention: The first species being a return enhancement module that enables users to create, modify and play a game with enhanced expected return for the player. The second species being a payout augmentation module that enables users to play games with larger prizes and to create and manage financial instruments whose sale enables game administrators to guarantee those prizes.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which

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are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

**Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).**

**Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 and 20-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter or the claimed invention lacks patentable utility.

Re. claim 1 and those that depend therefrom: a method for increasing the expected rate of return in the manner that is recited provides no substantial utility to those of one skill in the art of casino management and operations. A casino operator would never implement said method because it is contrary to the law and regulations that govern casino gaming in at least the two major areas of casino gaming: Nevada and New Jersey. The Patent Office does not grant rights of exclusivity to concepts that are contrary to the laws and regulations enacted to protect the public interest and promote public policy.

Re. claim 20 and those that depend therefrom: a system for increasing the expected rate of return in the manner that is recited has 1) no substantial utility for the reasoning given above and 2) is non-statutory subject matter because it does not provide one skilled in the art of casino management and operation a useful, concrete and tangible result. In other words, a casino operator would find no practical application for the system claimed because of the laws and regulation promulgated by at least the two largest gaming commissions in the United States; namely, Nevada and New Jersey.

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Re. claim 21 and those that depend therefrom: a method of creating financial instruments in the manner that is recited has 1) no substantial utility to one skilled in the casino operating and managing arts because a) a "financial instrument" broadly reasonable construed can mean "currency", e.g. the United States currency. Creating "United States currency", e.g. dollar bills, is forgery and is a federal crime. The Patent Office does not grant rights of exclusivity to concepts that clearly break federal law, e.g. the making of money. Also, the creation of "financial instruments" can also be construed to mean the creation of bonds and stock certificates, for example. The creation of such instruments brings into play the laws and regulations of the Security Exchange Commission, SEC. Again, the Patent Office does not grant rights of exclusivity to concepts that run against or test the SEC regulations regarding the creation and distribution of instruments falling under SEC jurisdiction. Also, financial instruments could be construed as "bank notes" which such manipulation said instruments falls under the laws and regulations of Federal and State banking laws. And likewise, the Patent Office does not grant rights of exclusivity to concepts that run against or test the laws regulations regarding the creation and distribution of such negotiable instruments falling under Federal and State

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jurisdiction. 2) non-statutory subject matter: if the creation of "financial instrument" is construed to be the formation of contract; contractual formation, obligations and enforcement is non-statutory subject matter.

Re. claim 28 and those that depend therefrom: the concepts recited in these claims are both non-statutory subject matter and no substantial utility to one of ordinary skill in the art for the reasoning given above regarding claims 21 through 25. In addition, the system as recited provide no useful, concrete and tangible result to one skilled in the art of casino management and operation. Which means for example, a casino operator in two of the largest gaming States, Nevada and New Jersey, would find no practical application for the system claimed because of the laws and regulation promulgated by these gaming commissions in the United States. The Patent Office does not granted rights of exclusivity to concepts prohibited by gaming commissions in order to protect the public interest through their public policies as set forth in their gaming laws and regulations.

Re. claim 29 and those that depend therefrom provide no substantial utility to one skilled in the art of casino management and operation because of what "financial instrument" can be construed to mean as recited above and the "selling" of

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such instruments depending on what said instruments are brings with it the laws and regulations of governing bodies the promulgate said laws and regulations for the protection of the public and further the public policy of the governing entity. The Patent Office does not grant rights of exclusivity on concepts that can be interpreted to go against public policy.

Re. claim 32: this claim provide no substantial utility to one skilled in the art of casino management and operation for all of the reasoning given above and incorporated herein.

In sum, with all of the above claims, one skilled in the art could not apply the concepts therein without the potential of running afoul of laws and regulations promulgated for the protection of public interest through the implementation of public policy by governing bodies that handle the transactions whereby which governing body would handle which transaction would depend on the interpretation of the concepts contain within the instant application.

*Drawings*

New corrected drawings are required in this application because the drawings are not clearly and cleaning lined and the character are not clearly printed, in other words, the drawings are hand sketches, which are not acceptable for patent publication. Applicant is advised to employ the services of a

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competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

*Specification*

A preliminary examination of this application reveals that it includes terminology which is so different from that which is generally accepted in the art to which this invention pertains that a proper search of the prior art cannot be made. For example: "the opportunity to participate in a game of return for a financial consideration from a player is not acceptable art terminology;" one skilled in the art would call it a wager or bet. One skilled in the art does not use the term "financial instrument" to describe the invention because of the issues of legality which have been described above. Instead, one skilled in the art uses terms such as "coin, currency, token, chip" or the like. It appears the specification is a business plan designed for someone either in the Harvard School of Business or Wharton School of Financial to comprehend and implement. However, one skilled in the art does not have an MBA and does not come from a "Ivy-League" school with a degree to match.

Applicant is required to provide a clarification of these matters or correlation with art-accepted terminology so that a proper comparison with the prior art can be made. Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

#### ***Conclusion***

It should be noted that when the Examiner examines the claims against the prior art, the Examiner will utilize art-recognized terminology when informing the Applicant why the claims are not patentable over the prior art of record. The Applicant had thus better become verse in said terminology that one of ordinary skilled in the art utilizes to describe concepts to others.

A preliminary examination of this application reveals to the Examiner that there is very little subject matter that would qualify as subject matter which the Patent Office would grant a patent thereon. It should be noted that because the Patent Office accepts a provisional application does not mean that the contents in said application qualifies as statutory subject matter or has utility under 35 U.S.C. § 101. Said provisional application are not examined by Examiners, they are screened by clerical staff for compliance with formalities listed in the

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regulations. To that which is present in the instant application which qualifies as statutory subject matter and has utility under the requirements of 35 U.S.C. § 101, the Examiner provides a skilled opinion that said subject matter is either anticipated or obvious in view of the prior art available to one of ordinary skill in the art. The Examiner has not provide an examination on the claims against the prior art because of the election of species requirement the Applicant must perform in order for the examination to proceed. The Examiner has provided a preliminary examination to inform the Applicant what claims are deemed non-statutory in order of the Applicant to make an informed election and correct the appropriate formalities issues with respect to the specification and drawings contained within the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 703-308-3484. The examiner can normally be reached on Monday through Friday 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J. Walberg can be reached on 703-308-1327. The fax phone number for the

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organization where this application or proceeding is assigned is  
(703) 872-9306.

Any inquiry of a general nature or relating to the status  
of this application or proceeding should be directed to the  
receptionist whose telephone number is 703-306-5648.

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MICHAEL O'NEILL  
PRIMARY EXAMINER